

**Application No.: 09/845,066**

### **REMARKS**

By this amendment, claims 1-19, 36, and 37 have been canceled without prejudice or disclaimer. New claims 38-82 have been added. The newly added claims 38-82 are fully supported by the specification as originally filed. Claims 38-82 are presently pending in this application. Reconsideration of this application for allowance of all pending claims are hereby respectfully requested in view of the amendments to the claims and the following remarks.

#### **Objections**

In Section 2 of the Office Action, dated October 4, 2005, claim 36 has been objected to as having an improper form because the claim depends on the canceled claim 35. By this amendment, claim 36 has been canceled. Therefore, the objection of claim 36 is presently moot.

In Section 4 of the Office Action, the Examiner objected to the abstract of the disclosure based on informality. By this Response, the Applicants have amended the Abstract in compliance with the MPEP §608.01(b). Therefore, the Applicants have overcome the objection of Abstract based on informality. The Applicants respectfully request that objection of the Abstract based on informality be withdrawn.

#### **Rejection Under 35 U.S.C. § 101**

In Section 6 of the Office Action, claims 1 and 3-19 have been rejected under 35 U.S.C. §101 with an assertion that the claimed invention is directed to non-statutory subject matter. By this Response, claims 1 and 3-19 have been canceled. Thus, the Examiner's rejection of claims 1 and 3-19 is presently moot.

Regarding the newly added claims, claims 38-74 and 81-82 are directed to machine-implemented automatic processes for customizing medical protocols for medical monitoring and

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delivering medication. The new claims 75-80 are directed to systems that are configured to perform the claimed processes. The Applicants respectfully point out that the technological art ground is no longer a legal ground for rejection. What is required is a real world practical application. An inventor has to show a useful, concrete, and tangible result. See *Ex Parte Lundgren* (BPA1 2005). The new claims 38-82 recite a practical application of the claimed processes and apparatuses in healthcare, where the recited application facilitates improved medical treatment, monitoring, and assistance to patients. The recited processes and apparatuses produce useful, concrete and tangible results, such as automatically customizing a medical treatment for a patient based on information related to the patient, automatically dispensing a medication to a patient according to such a customized medical treatment plan, or automatically administering a medical procedure based on an event occurred to the patient. Therefore, the new claims 38-80 are directed to statutorily permissible subject matter.

**Rejection Under 35 U.S.C. § 112**

In Section 8 of the Office Action, claims 3, 5-8, 10, 13-19, and 37 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since claims 3, 5-8, 10-19, and 37 have been canceled by this Amendment, the rejection of claims 3, 5-8, 10, 13-19, and 37 is moot.

**Rejection Under 35 U.S.C. § 102(e)**

In Section 10 of the Office Action, claims 1, 3, 4, 6-10, 12, and 37 have been rejected under 35 U.S.C. §102(e) as being anticipated by Linder et al. (U.S. Patent No. 6,681,003). Since

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claims 1, 3, 4, 6-10, 12, and 37 have been canceled by this Amendment, the rejection of claims 1, 3, 4, 6-10, 12, and 37 is moot.

In addition, the Applicants respectfully point out that the present specification has incorporated PCT patent application WO98/38909 by reference (see page 11, paragraph 134), which has a priority date of March 7, 1997. The invention as claimed in the newly added claims 38-82 are fully supported by the present specification as originally filed and by the incorporated PCT patent application.

**Rejection Under 35 U.S.C. § 103(a)**

In Section 13 of the Office Action, claims 2 and 5 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Linder et al. in view of Iliff (U.S. Patent Publication No. 2003/0153819 A1). Since claims 2 and 5 have been canceled by this Amendment, the rejection of claims 2 and 5 is moot.

In Section 14 of the Office Action, claim 11 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Linder et al. in view of Xue et al. (U.S. Patent No. 6,463,320). Since claim 11 has been canceled by this Amendment, the rejection of claims 2 and 5 is moot.

In Section 15 of the Office Action, claim 19 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Surwit et al. (U.S. Patent No. 6,589,169) in view of Xue et al. Since claim 19 has been canceled by this Amendment, the rejection of claims 2 and 5 is moot.

The Applicants respectfully point out that the present specification has incorporated PCT patent application WO98/38909 by reference (see page 11, paragraph 134), which has a priority date of March 7, 1997. The invention as claimed in the newly added claims 38-82 are fully

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supported by the present specification as originally filed and by the incorporated PCT patent application.

Accordingly, it is believed that all pending claims are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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